



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/689,281	10/11/00	CONSENZA	S 6056-277

HM12/0410
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EXAMINER

BAHAR, M	
ART UNIT	PAPER NUMBER

1617
DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/689,281

Applicant(s)

CONSENZA ET AL.

Examiner

Mojdeh Bahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Specie Election

Claims 1-10 and 12-22 are generic to a plurality of disclosed patentably distinct species comprising cytoprotective alpha, beta unsaturated arylsulfone compounds having specified substitutions on Q₁, Q₂, X₁-X₄, Y₁-Y₄ and R₁-R₁₀ to the core structure represented by Formula I (see claims 2-10).

Claims 1-10 and 12-22 as presented contain such a vast multitude of possibilities and permutations in the arylsulfone compounds that the search for each and every species encompassed in the claims presents an undue burden on the office. Accordingly, a requirement to provisionally elect a single independent and patentably distinct species is made as provided for in MPEP 803.02. It is considered that a Markush claim encompassing such species is directed to multiple independent and patentably distinct inventions since the species are so diverse and unrelated structurally that a reference anticipating one of the species would not anticipate or render obvious the other species. Thus, the stated species are capable of supporting separate patents. To illustrate this diversity, consider the following examples: a compound of Formula I wherein both Q₁ and Q₂ are unsubstituted phenyls and n=1, is classified in class 514, subclass 709; a compound of Formula I wherein Q₁ is the moiety recited in claim 3 where Y₁ is hydrogen, Y₂ is chlorine and X₁ is Nitrogen and Q₂ is a phenyl is classified in class 514, subclass 345; a compound of Formula I wherein Q₁ is the moiety recited in claim 3 (formula II) where Y₁ is hydrogen, Y₂ is chlorine and X₁ is Oxygen and Q₂ is a phenyl is classified in class 514, subclass 460; a compound of Formula I wherein Q₁ is the moiety recited in claim 3 where Y₁ is hydrogen, Y₂ is chlorine and X₁ is Nitrogen and Q₂ is the moiety recited in claim 3

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(formula III) wherein Y3 is Chlorine and Y4 is hydrogen, X4 is Sulfur and both X3 and X2 are Carbon is classified in class 514, subclass 444; a compound of Formula I wherein Q1 is the moiety recited in claim 3 where Y1 is hydrogen, Y2 is chlorine and X1 is Nitrogen and Q2 is the moiety recited in claim 3 (formula III) wherein Y3 is Chlorine and Y4 is hydrogen, X4 is Sulfur and X3 is Carbon and X2 is Nitrogen is classified in class 514, subclass 226.8.

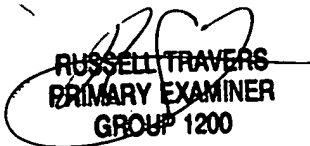
Therefore, the diversity of species in claims 1-10 and 12-22 requires a search of many different subclasses, 709, 345, 460, 444, 226.8, etc., in class 514 which constitutes an undue burden to the office. **Applicant is required to elect a specific arylsulfone compound for examination purposes.** Applicant is advised that the response to this requirement must include an identification of the species that is consonant with the requirement set forth in 35 U.S.C. 121 as well as a listing of all claims readable thereon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 from 8:30 a.m. to 6:30 p.m. Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner
April 4, 2001


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200